

REMARKS

Claims 29-37 and 39-44 remain pending in this application. Claims 41-44 are independent. Claims 41-44 have been amended. No claims have been added or canceled by this amendment.

Non-Statutory Subject Matter (Utility) Rejection Under 35 U.S.C. §101

Withdrawal of the rejection of claims 29-37 and 39-44 under 35 U.S.C. §101 as being directed to non-statutory subject matter is requested. Applicant respectfully traverses the Examiner's assertion that the claims are directed to non-statutory subject matter and/or that the claimed invention lacks utility.

Clearly, the claimed "testing device in a CAN-system" of claims 41-42; "testing device which permits testing at a first plurality of locations of a CAN-system" of claim 43; and "testing device for verifying operations of a CAN-system comprising a plurality of modules interconnected on a serial digital communication connection [or "bus"]" of claim 44 are specifically directed to a "device" which has a stated and easily understood utility.

Further, as stated in U.S. Patent Application Publication 2002/0044660 (this application):

[0028] Radiocommunication between control units and machines in machinery stocks can be economically established even where the machines operate with CAN-protocol. Repetition functions can be inserted into the CAN-system or the machine and/or process-control system, which means that connections can be established for even poorly accessible locations. Proven methods are in fact able to be used in connection with the radiocommunication control operation, as regards control desks, frequency usage, security arrangements, coding, keys, etc.

[0029] The above makes it possible for testing and function-checking to be easily carried out on CAN-modules, using simulated control operations and stimulations which are introduced to second modules at a distance from the first modules. The checks can be executed even if the connecting line is long, e.g. 800 m, or the modules are hidden from one another. The stimulations can also be carried out on the visually supervised module or

its equipment/components and the reactions to such stimulations can be obtained in a second direction within the CAN-system and recorded at the location for the first module(s).

Clearly, the above exemplary paragraphs indicate that the present application (and its claims) provide a well-established utility that is specific, substantial, and credible.

Claim 41 Recites Specific Structure

The Examiner erroneously asserts on page 3 of the Official Action that “[t]he steps do not perform the requested action...claim 41 does not recite any structure, i.e., there is no recitation of a machine to carry out the functions of all the recited steps...claim 41 recites non-statutory subject matter.”

Claim 41 recites “[a] testing device...comprising: a group of first modules...a second module...including a radio communication means and means for generating an activation message...a portable control unit having a radio communication means for establishing a radio communication link with said second module...”, among various other structural limitations imposed on certain ones of the above-referenced limitations by way of “wherein” clauses. Independent claims 42-44 recite similar structural limitations as indicated above. From the above, Applicant submits that claim 41, without question, recites definite structure, as do claims 42-44.

The Examiner should withdraw the §101 rejection at least based upon the above structural considerations associated with the claimed device. Additional consideration should be given to the utility requirement.

Discussion of the Utility Requirement

The MPEP interprets the Patent Laws and Rules, and in particular the statutory requirements under 35 U.S.C. §101.

I. SUBJECT MATTER ELIGIBILITY

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”¹

Decisions have determined the limits of the statutory classes. Examples of subject matter not patentable under the statute include:

- A. Printed Matter
- B. Naturally Occurring Article
- C. Scientific Principle

The presently claimed invention clearly does not fall under any of the above limiting classifications.

Further, the MPEP provides “Guidelines for Examination of Applications for Compliance with the Utility Requirement” in Chapter 2100 - Patentability.² Examiner are required to follow the policies and procedures established by the Guidelines in the evaluation of any patent application for compliance with the utility requirements of 35 U.S.C. 101.

The Guidelines include the following procedures when reviewing patent applications for compliance with the “useful invention” (“utility”) requirement of 35 U.S.C. §101 (*emphasis added*):

(A) Read the claims and the supporting written description.

(1) Determine what the applicant has claimed, noting any specific embodiments of the invention.

(2) Ensure that the claims define statutory subject matter (i.e., a process, machine, manufacture, composition of matter, or improvement thereof).

¹ MPEP §706.03(a)

² MPEP §2107

Amendment filed February 16, 2006

Reply to Office Action of November 18, 2005

(3) If at any time during the examination, it becomes readily apparent that the claimed invention has a well-established utility, do not impose a rejection based on lack of utility. An invention has a well-established utility if

- (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and
- (ii) the utility is specific, substantial, and credible.

(B) Review the claims and the supporting written description to determine if the applicant has asserted for the claimed invention any specific and substantial utility that is credible:

(1) *If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.*

(i) A claimed invention must have a specific and substantial utility. This requirement excludes "throw-away," "insubstantial," or "nonspecific" utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of 35 U.S.C. 101.

(ii) Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record (e.g., test data, affidavits or declarations from experts in the art, patents or printed publications) that is probative of the applicant's assertions. An applicant need only provide one credible assertion of specific and substantial utility for each claimed invention to satisfy the utility requirement.

(2) If no assertion of specific and substantial utility for the claimed invention made by the applicant is credible, and the claimed invention does not have a readily apparent well-established utility, reject the claim(s) under 35 U.S.C. 101 on the grounds that the invention as claimed lacks utility. Also reject the claims under 35 U.S.C. 112, first paragraph, on the basis that the disclosure fails to teach how to use the invention as claimed. The 35 U.S.C. 112, first paragraph, rejection imposed in conjunction with a 35 U.S.C. 101 rejection should incorporate by reference the grounds of the corresponding 35 U.S.C. 101 rejection.

(3) If the applicant has not asserted any specific and substantial utility for the claimed invention and it does not have a readily apparent well-

Amendment filed February 16, 2006

Reply to Office Action of November 18, 2005

established utility, impose a rejection under 35 U.S.C. 101, emphasizing that the applicant has not disclosed a specific and substantial utility for the invention. Also impose a separate rejection under 35 U.S.C. 112, first paragraph, on the basis that the applicant has not disclosed how to use the invention due to the lack of a specific and substantial utility. The 35 U.S.C. 101 and 112 rejections shift the burden of coming forward with evidence to the applicant to:

(i) Explicitly identify a specific and substantial utility for the claimed invention; and

(ii) Provide evidence that one of ordinary skill in the art would have recognized that the identified specific and substantial utility was well-established at the time of filing. The examiner should review any subsequently submitted evidence of utility using the criteria outlined above. The examiner should also ensure that there is an adequate nexus between the evidence and the properties of the now claimed subject matter as disclosed in the application as filed. That is, the applicant has the burden to establish a probative relation between the submitted evidence and the originally disclosed properties of the claimed invention.

(C) Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support the factual basis for the *prima facie* showing of no specific and substantial credible utility. If documentary evidence is not available, the examiner should specifically explain the scientific basis for his or her factual conclusions.

(1) Where the asserted utility is not specific or substantial, a *prima facie* showing must establish that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. The *prima facie* showing must contain the following elements:

(i) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is not both specific and substantial nor well-established;

(ii) Support for factual findings relied upon in reaching this conclusion; and

(iii) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

Amendment filed February 16, 2006

Reply to Office Action of November 18, 2005

(2) Where the asserted specific and substantial utility is not credible, a *prima facie* showing of no specific and substantial credible utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention. The *prima facie* showing must contain the following elements:

- (i) An explanation that clearly sets forth the reasoning used in concluding that the asserted specific and substantial utility is not credible;
- (ii) Support for factual findings relied upon in reaching this conclusion; and
- (iii) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(3) Where no specific and substantial utility is disclosed or is well-established, a *prima facie* showing of no specific and substantial utility need only establish that applicant has not asserted a utility and that, on the record before the examiner, there is no known well-established utility.

(D) *A rejection based on lack of utility should not be maintained if an asserted utility for the claimed invention would be considered specific, substantial, and credible by a person of ordinary skill in the art in view of all evidence of record.*³

Under the Guidelines, the Examiner must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement. In addition, it is essential for the Examiner to recognize, fully consider, and respond to each substantive element of any response to a rejection based on lack of utility. Only where the totality of the record continues to show that the asserted utility is not specific, substantial, and credible should a rejection based on lack of utility be maintained.

Applicant submits that such is not the case with the present application.

Finally, Applicant notes that, in 1980, the Supreme Court in *Diamond v. Chakrabarty* found that genetically engineered bacteria useful for cleaning up oil spills were patentable. In

³ MPEP §2107

writing for the majority, Chief Justice Burger cited the congressional report accompanying the 1952 Patent Act that Congress intended statutory subject matter to include anything under the sun that is made by man.

This general proposition that patentable subject matter includes “anything under the sun that is made by man” still governs today, and Applicant’s claimed invention is drawn to patentable subject matter.

Allowable Subject Matter and Amendments to the Claims

Applicant notes with appreciation that claims 29-37 and 39-44 would be allowed if the lack of utility rejection is overcome.

Although Applicant believes that each of the previously pending claims 29-37 and 39-44 in this application fully met the utility requirement under 35 U.S.C. §101 and were thereby drawn to statutory subject matter, in the interests of expediting prosecution of this application to issue, the pending independent claims 41-44 have been amended so as to clarify their recitations. There is no new matter with any claim amendment.

Reconsideration and allowance of pending claims 29-37 and 39-44 are respectfully requested.

Conclusion

In view of the above amendment and remarks, Applicants believe that each of pending claims 29-37 and 39-44 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

Application No. 09/847,326

Docket No.: 20260-00044-US4

Amendment filed February 16, 2006

Reply to Office Action of November 18, 2005

Although no fees are believed to be due with this response, for any fees that are due, including fees for extensions of time, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application to CBLH Deposit Account No. 22-0185, under Order No. 20260-00044-US4 from which the undersigned is authorized to draw.

Respectfully submitted,

By Larry J. Hume
Larry J. Hume

Registration No.: 44,163
CONNOLLY BOVE LODGE & HUTZ LLP
Correspondence Customer Number: 30678
Attorney for Applicant

Attachments: Substitute Specification ("Marked-up" version)
Substitute Specification ("Clean" version)